

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

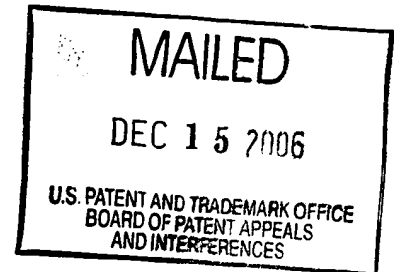
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex Parte TOMOTOSHI SATO

Appeal No. 2006-0094
Application No. 09/668,005

ON BRIEF



Before HAIRSTON, KRASS and SAADAT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-76.

The invention pertains to virtual print previewing, best illustrated by reference to representative independent claim 1, reproduced as follows:

1. A method for previewing an electronic document, the method comprising:

generating the electronic document as a client;

transmitting document information associated with the electronic document from the printouts of electronic documents at the printing device;

the printing device generating preview document data based on the document information and a set of one or more specific characteristics associated

with the printing device, wherein the set of one or more specific characteristics are unavailable at the client;

the printing device transmitting the preview document data to the client; and

previewing the electronic document at the client based on the preview document data received from the printing device.

The examiner relies on the following references:


Bando	6,449,053	Sep. 10, 2002 (filed July 16, 1997)
Blumberg et al. (Blumberg)	2003/0140315	July 24, 2003 (filed Jun. 07, 1999)

Claims 1-12, 14-39, 41-56, and 58-76 stand rejected under 35 U.S.C. §102(e) as anticipated by Blumberg. Claims 13, 40, and 57 stand rejected under 35 U.S.C. §103 as unpatentable over Blumberg in view of Bando.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

OPINION

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder CO. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Taking claim 1 as exemplary, the examiner argues that Blumberg discloses a method for previewing an electronic document at paragraph 0009; a generation of the electronic document at a client, at paragraphs 0011 and 0143; and a transmission of document information from the client to a printing device in Figures 2 and 3 and in paragraphs 0058 through 0074 and paragraphs 0141 through 0154.  In particular, the examiner cites Blumberg's Virtual Builder in paragraphs 0060, 0061, 0065-0073, 0075 and 0076. The examiner contends that the claimed "printing device generating preview document data based on the document information..." is taught by Blumberg at paragraphs 0011, 0012, and 0064-0083. The claimed transmission of the preview document data to the client by the printing device is said by the examiner to be taught by Blumberg at paragraphs 0064-0083, and "previewing the electronic document at the client based on the preview document data received from the printing device" is said to be taught at paragraphs 0075-0090 of Blumberg.

Appellant contends that Blumberg fails to teach "the printing device generating preview document data based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client" and "printing device having a print process executing thereon for generating hard-copy printouts of electronic documents at the printing device."

With regard to the examiner's reliance on Blumberg's Virtual Builder, appellant acknowledges that Blumberg's Virtual Builder may reside on client computers or server computers, or both, and that the Virtual Builder software 320 can be part of on-demand print service 310 in on-line on-demand print facility 300. However, appellant argues that Blumberg

does not teach or suggest that the Virtual Builder software can reside on a printing device, as claimed (see page 5 of the brief). In particular, appellant points out that Blumberg discloses local printing 260 and printing devices located at the corporate reproduction center 280, local reproduction center 370 and remote production center 380, but argues that none of these printing devices can execute the Virtual Builder software or otherwise be configured to generate preview document data and provide the preview document data to a client, as recited in claim 1. That is, according to appellant, Blumberg fails to show any printing device that participates in generating document preview data.

Thus, it appears to us that the examiner has it right when the examiner states that the issue here is whether Virtual Builder of Blumberg resides on a “printing device.”

The examiner states that Figure 1A of the instant application shows a printing device 102 which includes a server process 114 that receives print preview requests from a client, and that the printing device in Figure 1B includes a web server 114 and a system bus 130 that allows a client to communicate with the printing device. The examiner points out that appellant’s printing device’ comprises several different components of computer hardware and software, all of which contribute to the printing of a document, and that the entire computer system of the instant invention, as in Figure 5, is described as a “printing device” computer system, referring to page 17, line 12 of the specification.

Therefore, the examiner concludes that, as broadly disclosed in the instant specification, it is reasonable to find that the term, “printing device” is broad enough to include every piece of

computer hardware that includes the Virtual Builder software in Blumberg, and that the Virtual Builder software itself may be considered a “printing device.” Since it is clear that the Virtual Builder software generates document previews, the examiner concludes, reasonably in our view, that the claimed printing device for generating preview document data is described by Blumberg. We find no error in the examiner’s rationale and appellant offers no explanation in rebuttal showing any such error.

Appellant argues that Blumberg does not disclose that the preview generation is based on document information and a set of one or more specific characteristics associated with the printing device, “wherein the set of one or more specific characteristics are unavailable at the client,” since finishing options of the Virtual Builder software are selected by the user at the client and therefore are available at the client.

However, we agree with the examiner. The examiner points out that the finishing options presented to the client user through Virtual Builder are unavailable at the client because these finishing options are available only through accessing the Virtual Builder software, which resides on the servers, so that unless the client accesses the Virtual Builder software, these finishing options are “unavailable at the client,” as claimed. The examiner’s explanation appears reasonable to us and appellant has offered nothing in rebuttal to show any error in the examiner’s reasoning.

Since we have found the examiner to have presented a prima facie case of anticipation and we have addressed each of appellant’s arguments, finding none of them persuasive of any

Appeal No. 2006-0094
Application No. 09/668,005

error in the examiner's rationale, we will sustain the rejection of claim 1 under 35 U.S.C. §102(e).


Moreover, we will sustain the rejection of claims 2-12, 14-39, 41-56, and 58-76 under 35 U.S.C. §102(e), as well as the rejection of claims 13, 40, and 57 under 35 U.S.C. §103, since appellant offers the same arguments relative to these claims as were presented with regard to claim 1.

The examiner's decision is affirmed.


Appeal No. 2006-0094
Application No. 09/668,005

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED


KENNETH W. HAIRSTON
Administrative Patent Judge


ERROL A. KRASS
Administrative Patent Judge


MAHSHID D. SAADAT
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

EK/gw

Appeal No. 2006-0094
Application No. 09/668,005

HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE SUITE 550
SAN JOSE, CA 95110